

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/591,448

Applicant(s)

SEITZ, JOHANN

Examiner

ZEEV KITOV

Art Unit

2836

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 June 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1 - 5, 7 - 11, 13 - 15, 17 - 21.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see below.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Stephen W Jackson/
Primary Examiner, Art Unit 2836

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Applicant attacks the Office Action for using an inherency concept. The Office Action states following: "In the Kumar device modified according to teachings of Guery et al. the fuse is being incorporated into the same modular structure as the circuit breaker (see above) and any circuit breaker including those of Kumar (126, 134 in Fig. 1) inherently includes the switching element in either electromechanical or semiconductor form, i.e. either contacts operated by electromechanical relay or the semiconductor switching element, since the concept of the circuit breaker is based on interruption of the power supply when some failure occurs, the operation which is impossible without the switch".

Applicant attacks this statement as follows: "to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by person of ordinary skill".

Examiner believes that person of ordinary skill in the art, i.e. a normal electrical circuit designer would not have any difficulty to recognize that the circuit breaker must include the switching element especially in view of a following definition provided by web Encyclopedia answers.com: "A circuit breaker is an automatically-operated electrical switch designed to protect an electrical circuit from damage caused by overload or short circuit. Its basic function is to detect a fault condition and, by interrupting continuity, to immediately discontinue electrical flow".

Applicant further alleges that Guery specifically states that "standardization prohibits the use of switches as isolating members". The Applicant takes this phrase out of context to use it as evidence that Guery "teaches away from use of the switch".

However, this transitional phrase in Guery is followed by the following statement: "Thus, any installation must associate with the circuit breaker (manual or automatic) a specific device ensuring the isolating function such for example an isolating switch, an isolating fuse holder, isolating terminals, etc. . .". Moreover, Guery describes his device shown in Fig. 9, as follows: "FIG. 9 is a schematic section of a combined isolating switch-circuit breaker with rotary mobile assembly equipped with a fuse holder". Therefore even the name of the device includes the term "switch". Therefore, Guery by no means teaches away from using the switch.

Applicant further alleges: "there is no suggestion or motivation to combine the references as proposed due to the teaching away of Guery". However, Guery by no means discourage someone from use of the switch and therefore there is no teaching away from using the switch.

As to motivation for combining references together the Office Action provided sufficient rationale for that: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Kumar device by incorporating the fuse into the integrated structure with the circuit breaker according to teachings of Guery et al. because as Guery et al. states (col. 1, lines 24 – 31): "any installation must associate with the circuit breaker (manual or automatic) a specific device ensuring the isolating function such for example an isolating switch, an isolating fuse holder, isolating terminals, etc. This addition of an isolating switch therefore increases the complexity of the installation and increases its cost". Therefore, according to Guery et al. combining the circuit breaker and the fuse in the same integrated structure will reduce the complexity of the structure and cost of the device".

Applicant further attacks the Examiner statement with regard to the equal width in the modular devices in the Al-Sabah reference (Fig. 13). Applicant recites MPEP 2115: "When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value". See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55USPQ2d 1487, 1491 (Fed. Cir. 2000).

However, the same MPEP section further states following: "However, the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art". In *re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). In the instant case, the dimensional conclusion was not based only on the picture but on a whole concept of modular design demonstrated by Al-Sabah (col. 2, line 66 – col. 3, line 18). Fig. 3 shows a main power distribution module (22 in Fig. 3) with associated auxiliary power distribution modules (42 in Fig. 3). As clearly shown in the Fig. 3, the flat side walls of the main power distribution module (30 in Fig. 3) essentially spatially coincide with corresponding side walls of the auxiliary power distribution modules. It is true for both ends of the main and auxiliary power modules. Even without proper scaling of the picture, such conclusion may be drawn from the Fig. 3 Drawing in full accordance with *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Moreover, Fig. 3 clearly demonstrates that both the main power distribution module and the auxiliary power distribution modules are essentially flat to the same extend, i.e. none of them is shown bulging with respect to another, which improves the appearance of combined structure.

Besides that the equal width dimensions were stated as a conclusion in the following statement: "(3) making contacting surfaces of the modules of equal width saves a space and allows easy replacement of the modules". Accordingly, the equal width dimensions are properly established in the Office Action.